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08/020,675

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08/020,675	02/22/93	KELLER	J KELL-20,889

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FUNK, S EXAMINER

ART UNIT	PAPER NUMBER
3307	6

DATE MAILED: 03/10/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined

Responsive to communication filed on 1/21/94

This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 15 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of informal Patent Application, Form PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 1-13 are pending in the application.

Of the above, claims 6 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-5 + 7-13 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable. not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner. disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed on _____, has been approved. disapproved (see explanation).

12. Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Applicant's election with traverse of claims 1 - 5 and 7 - 13 in Paper No. 5 is acknowledged. The traversal is on the grounds that the inventions are not truly independent and the determination of distinctiveness under M.P.E.P. §806.05(c) is permissive not mandatory. This is not found persuasive because the combination - subcombination restriction is proper, as acknowledged by applicant, and deemed necessary since they have acquired a separate status in the art because of their recognized divergent subject matter and the search for claim 6 is not required for claims 1 - 5 and 7 - 13. The specific details of the oscillating mechanism in claim 6 would not be required for claims 1 - 5 and 7 - 13 and, therefore, would pose an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim 6 is withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

The drawings are objected to because reference numerals (38) and (40) appear to indicate the same structure in Figure 1. Correction is required.

The disclosure is objected to because of the following informalities: On page 2 line 10 "form" should presumably be --pan--. The sentence on page 11 lines 16 - 18 has no clear meaning. On page 11 line 23 and page 13 line 7 reference numeral "32" should be --30--. On page 13 line 15 reference numeral "40" should presumably be --38--. On page 16 line 32 and page 18 line 5 the reference to "Figure 5" should presumably be --Figure 4--. On page 17 line 15 the reference to "Figure 6" should presumably be --Figure 5--. On page 18 lines 3 - 4 the reference to Figures 6 - 8 should be to Figures 5 - 7 since there is no Figure 8 in the drawings.

Additionally, reference numerals (60), (13), and (23), are not addressed in the specification.

See Figures 1 and 2. Applicant should carefully review the specification for any additional errors not noted above. Appropriate correction is required.

Claims 1 - 5, 7 - 11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 14 "said oscillating roller gear" lacks proper antecedent basis. In claim 3 the recitation "transfer roller" should be --transfer roller means-- so as to be consistent with the previous recitation.

In claim 7 lines 10 - 11 "said reverse direction transfer roller" lacks proper antecedent basis. Note the terminology previously recited. In line 22 "said transfer roller" is vague and indefinite. It is not clear which transfer roller is being referred to. Note that the oscillating roller has been previously recited as being in contact with the reverse direction transfer roller. Claim 11 does not set forth any structure to limit the parent claim but rather sets forth the method by which the ink receptive surface is formed. Accordingly, this is not a proper limitation of an apparatus claim.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to

provide an enabling disclosure. It is not apparent how etching the surface of an existing dampening roller renders it ink receptive. There is no disclosure of what the etching solution comprises to provide the end result. See page 17 line 32 through page 18 line 2 of the specification.

Claim 11 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1 - 5 are rejected under 35 U.S.C. § 103 as being unpatentable over applicant's admission of the prior art as found in the preamble of Jepson claim 7 in view of Fadner et al. (US 5,107,762). Applicant admits in the preamble of Jepson claim 7 that the particular sequence of the dampening rollers is known in the art. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). The primary difference between the prior art and applicant's invention is that the oscillating roller has an ink receptive surface. Fadner et al. teach the desirability of providing all of the rollers in a dampening train with an ink receptive surface to enhance the transfer of

the dampening fluid to the plate cylinder. See the entire disclosure of Fadner et al., in particular, column 8 lines 35 - 61. It would have been obvious to one of ordinary skill in the art to provide the oscillating roller in a conventional dampening roller train with an ink receptive surface in view of Fadner et al. to provide a thin, but adequate, supply of dampening fluid to the plate cylinder. Note that Fadner et al. teach that all of the rollers are rotated at a surface speed proportional to the surface speed of the plate cylinder.

Claims 7 - 11 are rejected under 35 U.S.C. § 103 as being unpatentable over Fadner et al. in view of Omori (US 4,524,690). The preamble of Jepson claim 7 sets forth the sequence of the rollers in a conventional dampening train. Applicant's improvement to the prior art comprises the oscillating roller having an ink receptive surface, a gear train for driving the oscillating roller at a speed proportional to the speed of the plate cylinder, and means for applying a desired contact force between the oscillating roller and the transfer roller and the oscillating roller and the form roller. Fadner et al. teach the desirability of providing all of the rollers in a dampening train with an ink receptive surface to enhance the transfer of the dampening fluid to the plate cylinder. Omori teaches the conventionality of adjusting the pressure between each of the rollers in a dampening train. It would have been obvious to one of ordinary skill in the art to provide a conventional dampening roller train with an ink receptive oscillating roller in view of Fadner et al. to provide a thin, but adequate, supply of the dampening fluid to the plate cylinder and with means for applying a desired contact force between the oscillating roller, the form roller, and the transfer roller in view of Omori to accurately meter the dampening fluid. With respect to claims 8 - 10 Fadner et al. teach the

conventionality of covering the rollers with rubber or nylon. See column 3 lines 57 - 62 Fadner et al. With respect to claim 11, insofar as it is supported by the specification, it would have been obvious to one of ordinary skill in the art to use an etching solution to provide the oscillating roller with the desired ink receptivity. Etching is a well known technique in the art to achieve the desired roller surface characteristics.

Claims 12 and 13 are rejected under 35 U.S.C. § 103 as being unpatentable over applicant's admission of the prior art as found in the preamble of Jepson claim 7 and in the specification on page 2 line 8 through page 5 line 15 in view of Fadner et al. and Omori. Applicant admits in the preamble of Jepson claim 7 that the particular sequence of the dampening rollers is known in the art. Furthermore, applicant admits in the specification that it is well known in the art to provide means for adjusting the contact pressure between the pan roller and the transfer roller. Fadner et al. teach the desirability of providing all of the rollers in a dampening train with an ink receptive surface to enhance the transfer of the dampening fluid to the plate cylinder. Omori teaches the conventionality of adjusting the pressure between each of the rollers in a dampening train. It would have been obvious to one of ordinary skill in the art to provide a conventional dampening roller train with an ink receptive oscillating roller in view of Fadner et al. to provide a thin, but adequate, supply of the dampening fluid to the plate cylinder and with means for adjusting the contact pressure between the rollers in view of applicant's admission of prior art and Omori to accurately meter the dampening fluid. While the claims specifically recite a kit and method for retrofitting a conventional dampening train, it would have been obvious to one of ordinary skill in the art to modify an existing press in view

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of the teachings of Fadner et al. and Omori.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Palecek et al., Fischer, and Rogers also teach ink receptive rollers in a dampening roller train.

Any inquiry concerning this communication should be directed to Stephen Funk at telephone number (703) 308-0982.

Edgar S. Burr
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S.P.E.
GROUP ART UNIT 337

Stephen Funk

Stephen Funk

March 4, 1994